The opinion in support of the decision being entered today is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOSEPH PHILLIP BIGUS,
BRIAN JOHN CRAGUN, AND HELEN ROXLO DELP

Appeal 2007-0613
Application 09/100,595
Technology Center 2100

Decided: July 24, 2007

Before KENNETH W. HAIRSTON, HOWARD B. BLANKENSHIP, and JAY P. LUCAS, *Administrative Patent Judges.*

HAIRSTON, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 from a non-final rejection of claims 30 to 32, 36 to 45, 47 to 60, 62 to 74, and 76 to 80. We have jurisdiction under 35 U.S.C. § 6(b).

Appellants have invented a program product, method, and system for handling a computer task by configuring an intelligent agent computer program to execute at least one selected program module to perform a task (Specification 7).

Claim 30 and 49 are representative of the claims on appeal, and they read as follows:

30. A program product comprising:

(a) a program configured to perform a computer task using an intelligent agent, the program comprising an intelligent agent including at least one of a plurality of program modules having varied degrees of autonomy, wherein the plurality of program modules are each configured to handle a common computer task that includes conducting negotiations in an electronic commerce application, and wherein, based upon an objective criteria, at least one selected program module from the plurality of program modules is selected to handle the computer task; and

(b) a signal bearing media bearing the program.

49. A method of handling a computer task using an intelligent agent, the method comprising the steps of:

(a) based upon an objective criteria, selecting at least one selected program module from a plurality of program modules having varied degrees of autonomy, wherein the plurality of program modules are each configured to handle a common computer task that includes conducting negotiations in an electronic commerce application; and

(b) configuring an intelligent agent to execute the at least one selected program module to handle the computer task.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Atkins	US 5,875,437	Feb. 23, 1999 (filed Apr. 15, 1997)

The Examiner rejected claims 49 to 60, 62 to 74, and 76 to 80 under 35 U.S.C. § 101 for being directed to non-statutory subject matter because "[t]he claims merely manipulate abstract ideas in general without limitation to a practical application where 'certain substances' are transformed or reduced" (Non-final Rejection 3).

The Examiner rejected claims 30 to 32, 36 to 45, 47 to 60, 62 to 74, and 76 to 80 under 35 U.S.C. § 102(e) based upon the teachings of Atkins.

Appellants contend that "[t]he selection of a program module recited in each of the aforementioned claims is not merely a manipulation of abstract ideas or mathematical formulas, but rather a useful, concrete, and tangible result . . . obtained by virtue of the optimization of the operation of an intelligent agent in performing the recited computer task" (Br. 7). With respect to the prior art rejection, Appellants contend that "*Atkins* is silent as to providing a plurality of program modules that are each specifically 'configured to handle a common computer task that includes conducting negotiations in an electronic commerce application'" (Br. 10).

We will reverse the non-statutory subject matter rejection and the prior art rejection.

ISSUES

Are the claims on appeal directed to statutory subject matter?

Does Atkins describe an intelligent agent that specifically configures each of a plurality of program modules to handle a common computer task?

FINDINGS OF FACT

(NON-STATUTORY SUBJECT MATTER)

According to the Examiner, "Applicant discloses no 'certain substances' in the sense that Applicant's claims disclose no *specific* computer-readable medium, no manipulation of *specific* data representing physical objects or activities (pre-computer activity), nor do they disclose any *specific* independent physical acts being performed by the invention (post-computer activity)" (Non-final Rejection 3).

As indicated *supra*, Appellants contend that the claims on appeal are directed to statutory subject matter because they recite an intelligent agent that is configured to select at least one program module to perform a common computer task of conducting negotiations in an electronic commerce application. Appellants also contend that "[n]one of the claims therefore are broad enough to encompass the mere manipulation of abstract ideas" (Br. 7).

PRINCIPLES OF LAW

(NON-STATUTORY SUBJECT MATTER)

Laws of nature, physical phenomena and abstract ideas are excluded from patent protection. *Diamond v. Diehr*, 450 U.S. 175, 185, 209 USPQ 1, 7 (1981).

The test for statutory subject matter is whether the claimed subject matter is directed to a "practical application," i.e., whether it is applied to produce "a useful, concrete and tangible result." *See State St. Bank & Trust Co. v. Signature Fin. Group, Inc.*, 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1601 (Fed. Cir. 1998).

In any rejection, the initial burden is on the Examiner to establish a prima facie case. *In re Oetiker*, 977 F.2d 1443, 1444, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

ANALYSIS

(NON-STATUTORY SUBJECT MATTER)

Simply stated, the Examiner's position is untenable because the claims on appeal clearly go beyond the mere recital of an abstract idea. The claims on appeal do not preempt any abstract idea or mathematical algorithm, and they are not "broad enough to encompass the mere manipulation of abstract ideas." In the absence of other grounds for finding the claims to be directed to non-statutory subject matter, we cannot sustain the Examiner's position.

FINDINGS OF FACT
(ANTICIPATION)

Atkins describes a method and apparatus that provide an integrated financial product package (col. 1. ll. 22 and 23). Atkins uses personal digital assistants that are linked to central processors and data storage facilities (col. 7, ll. 27 to 30). Atkins also uses an objective expert advisor (e.g., an intelligent agent) (col. 8, ll. 37 to 40). When multiple problem solving techniques are required in Atkins, the intelligent agent acts so that "each problem solving technique is applied to the appropriate aspect of the problem" (col. 29, ll. 32 to 36).

PRINCIPLE OF LAW
(ANTICIPATION)

Anticipation is established when a single prior art reference discloses expressly or under the principles of inherency each and every limitation of the claimed invention. *Atlas Powder Co. v. IRECO Inc.*, 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1946 (Fed. Cir. 1999); *In re Paulsen*, 30 F.3d 1475, 1478-79, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994).

ANALYSIS
(ANTICIPATION)

In Atkins, the intelligent agent uses the multiple problem solving techniques (i.e., program modules) to solve pieces of the whole problem. Each problem solving technique is not capable of solving the whole problem as required by each of the claims on appeal.

CONCLUSIONS OF LAW

The Examiner has not presented a convincing line of reasoning that establishes that claims 49 to 60, 62 to 74, and 76 to 80 are directed to non-statutory subject matter.

Anticipation has not been established by the Examiner because Atkins does not disclose each and every limitation of the claimed invention set forth in claims 30 to 32, 36 to 45, 47 to 60, 62 to 74, and 76 to 80.

DECISION

The non-statutory subject matter rejection of claims 49 to 60, 62 to 74, and 76 to 80 is reversed.

The anticipation rejection of claims 30 to 32, 36 to 45, 47 to 60, 62 to 74, and 76 to 80 is reversed.

REVERSED

KIS

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